

**REMARKS**

In the May 11, 2007 Office Action, the Examiner noted that claims 1, 2, 4, 6 and 8-18 were pending in the application and were rejected under 35 USC § 103(a). In rejecting the claims, U.S. Patents 5,802,518 to Karaev et al. (Reference A in the June 9, 2006 Office Action); 5,502,637 to Beaulieu et al. (Reference A in the May 11, 2007 Office Action); 6,717,938 to D'Angelo; and 6,563,517 to Bhagwat et al. (References B and C, respectively, in the May 6, 2005 Office Action) were cited. Claims 8, 11 and 15 have been canceled and thus, claims 1, 2, 4, 6 and 9, 10, 12-14 and 16-18 remain in the case. The rejections are traversed below.

**Rejections under 35 USC § 103**

In items 9-12 on pages 3-6 of the May 11, 2007 Office Action, claims 1, 2, 8-12 and 15-18 were rejected under 35 USC § 103(a) as unpatentable over Karaev et al. in view of Beaulieu et al. In rejecting claim 1, it was asserted that column 6, lines 21-43 of Karaev et al. discloses "accepting, by one terminal device, as one set of data provision information, recipient information relating to a recipient who is authorized to receive said provision information, and a provision format of said provision information to be applied to said recipient" (Office Action, page 4, lines 1-4) and that column 15, line 60 to column 16, line 7 of Karaev et al. discloses "providing, by said central apparatus to said one of the terminal devices which transmitted the request and the recipient information, the provision information corresponding to the provision format based on the recipient information registered in the one set of data" (Office Action, page 4, lines 13-16).

The cited portion of column 6 in Karaev et al. states that "the contributor selects a report for distribution ... [that] may be in any standard electronic format ..., Pagemaker, Microsoft Word for Windows, Corel WordPerfect, etc." (column 6, lines 22-28). Meanwhile, the cited portions of columns 15 and 16 describe some of the "strings [that] appear in the 'name' of the submit button" (column 15, lines 26-27), "[w]hen an investor submits a query" (column 15, lines 23-24) to obtain one or more of the reports provided by a contributor. No mention has been found in columns 6, 15 and 16 of Karaev et al. that the contributor can specify a format used for distribution.

On the other hand, all of the independent claims now recite a method or device that is able to provide "provision information in the portable document format or the original format corresponding to the provision format based on the recipient information registered in the one set of data" (e.g., claim 1, last 3 lines) as described, for example, in the application on pages 5

and 6. This is made possible in the method recited in claim 1 by "accepting, by one terminal device" (claim 1, line 5),

as one set of data provision information, recipient information relating to a recipient who is authorized to receive said provision information, and a provision format of said provision information to be applied to said recipient, the provision format including a portable document format which is converted from provision information at the terminal device and an original format which is not converted from provision information

(claim 1, lines 5-9). Similar limitations are recited on lines 7-11 of claim 2, lines 4-8 of claim 9, lines 4-9 of claim 10, lines 7-11 of claim 12 and lines 3-8 of claim 16. According to claim 17, the provision format is specified when

any user who is authorized to store format information for provision information, [inputs] the format information for each authorized recipient of the provision information, the format information indicating at least one provision format selected from among at least an original format and a portable document format

(claim 17, lines 3-6), as described, e.g., at page 5, line 13 to page 6, line 2 of the application.

As discussed in the Amendment filed April 19, 2007, Karaev et al. does not disclose specifying this type of format and, it is submitted that Beaulieu et al. does not provide any suggestion of modifying Karaev et al. to include specification of a file format, only that a portable document format can be generated at a user terminal. The May 11, 2007 Office Action did not respond to the following arguments presented in the Amendment filed April 19, 2007.

Nothing has been cited or found in Karaev et al. suggesting specification of one of two formats for a file that is distributed to recipients. Rather Karaev et al. discloses that "the information provider may require that the format of the information provided to one user be different from the format of the same information provided to another user or class of users" (column 1, lines 37-41) without any suggestion that those formats include "a portable document format ... and an original format" (e.g., claim 1, lines 8-9). Similarly the cited portion of column 4 refers to "template forms, for each type of query, for each user or class of user, etc. Thus, each user or class of users may receive information in a format defined for that user or class of users" (column 4, lines 56-59). The term "template forms" is used to refer to "the output format of the information provided to users" (column 4, lines 61-62) which use is described as advantageous, because it is possible to use "[t]emplate forms ... without having to 'hardcode' any program" (column 4, lines 63-64).

In other words, Karaev et al. uses the word "format," at least in column 4, to refer to the arrangement of data being output and thus, is closer to the first definition of "format" at Merriam-Webster Online ([www.m-w.com/cgi-bin/dictionary?book=Dictionary&va=format](http://www.m-w.com/cgi-bin/dictionary?book=Dictionary&va=format)), "the shape, size,

and general makeup (as of something printed)" rather than the third definition, "a method of organizing data (as for storage) <various file formats>." These same distinctions can be found at ([dictionary.cambridge.org/define.asp?key=30628&dict=CALD](http://dictionary.cambridge.org/define.asp?key=30628&dict=CALD)) the online Cambridge Advanced Learner's Dictionary in the first definition of "format" as a verb, "to organize or arrange text, especially on a computer, according to a chosen pattern" and the second definition of "format" as a noun, "the way in which information is arranged and stored on a computer." Clearly, it is the third Merriam-Webster Online definition of "format" that is used for the term "provision format" in the claims which recite that "the provision format includes a portable document format" (e.g., claim 1, lines 7-8) and in the specification which states that one example of a portable document format is the well-known data storage format produced by Adobe Acrobat (see the paragraph starting at page 15, line 13).

Nothing has been found in the combination of Karaev et al. and Beaulieu et al. that suggests a user of the system disclosed by Karaev et al. specifies "the format information for each authorized recipient of the provision information, the format information indicating at least one provision format selected from among at least an original format and a portable document format" (claim 17, lines 4-6), where the meaning of the term "provision format" is consistent with the third Merriam-Webster Online definition. It is submitted that one of ordinary skill in the art would not find it obvious to specify a data storage format for recipients in the manner recited in the claims under examination from the disclosure in Karaev et al. of template forms defining the arrangement of data output to users or anything else in Karaev et al. and Beaulieu et al. Limitations similar to those quoted above from claim 1 are recited in the other independent claims. Therefore, it is submitted that independent claims 1, 2, 9, 10, 12, 16 and 17, as well as claim 18 which depends from claim 17, patentably distinguish over Karaev et al. in view of Beaulieu et al.

In items 13-16 on pages 6-7 of the May 11, 2007 Office Action, claims 4 and 13 were rejected under 35 USC § 103(a) as unpatentable over Karaev et al. in view of Beaulieu et al. and D'Angelo. Claim 4 depends from claim 2 and claim 13 depends from claim 12. Nothing was cited or has been found in D'Angelo suggesting modification of Karaev et al. and Beaulieu et al. to overcome the deficiencies discussed above. Therefore, it is submitted that claims 4 and 13 patentably distinguish over the combination of Karaev et al., Beaulieu et al. and D'Angelo for the reasons discussed above with respect to claims 2 and 12.

In items 17-20 on pages 7-9 of the May 11, 2007 Office Action, claims 6 and 14 were rejected under 35 USC § 103(a) as unpatentable over Karaev et al. in view of Beaulieu et al. and

Bhagwat et al. Claim 6 depends from claim 2 and claim 14 depends from claim 12. Nothing was cited or has been found in Bhagwat et al. suggesting modification of Karaev et al. and Beaulieu et al. to restrict access by format of information provided to users. Therefore, it is submitted that claims 6 and 14 patentably distinguish over Karaev et al. in view of Beaulieu et al. and Bhagwat et al. for at least the reasons discussed above with respect to claims 2 and 12.

### Summary

It is submitted that the references cited by the Examiner do not teach or suggest the features of the present claimed invention. Thus, it is submitted that claims 1, 2, 4, 6, 9, 10, 12-14 and 16-18 are in a condition suitable for allowance. Reconsideration of the claims and an early Notice of Allowance are earnestly solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935..

Respectfully submitted,

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